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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/852,928   | 05/10/2001  | Al Pilcher           | GOW 0083 PA         | 7068             |
| 7590   | 11/30/2004  |                      | EXAMINER            |                  |
| Killworth, Gottman, Hagan & Schaeff, L.L.P.<br>One Dayton Centre, Suite 500<br>Dayton, OH 45402-2023 |             |                      | GARG, YOGESH C      |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3625                |                  |

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/852,928             | PILCHER, AL         |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Yogesh C Garg          | 3625                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 09 September 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,4-8,10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,4-8,10 and 11 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)                    4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Response to Amendment***

1. Applicant's amendment received on 9/9/2004 is acknowledged and entered. The applicant has confirmed previously withdrawn claims 2-3 and 12-22 and has cancelled claim 9. The applicant has amended claims 1, 4, 6 and 7. Currently claims 1, 4-8 and 10-11 are pending for examination.

### ***Response to Arguments***

2.1. The examiner acknowledges receipt of the certified copy of the Canadian Patent application as required by 35 U.S.C. 119(b) from which the applicant has made a claim for foreign priority to the instant application.

2.2. Applicant's arguments, see page 8 of the Remarks, filed on 9/9/2004, with respect to claim 6 have been fully considered and are persuasive in view of the amendment made to the claim 6. The rejection of claim 6 under 35 U.S.C. 112, second paragraph has been withdrawn.

2.3. Applicant's arguments filed on 9/9/2004 with respect to rejection of claims 1, 4-11 under USC 103 (a), see pages 8-11 of the "Remarks" have been fully considered but they are not persuasive. For following reasons:

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The applicant argues that the amended independent claim 1 teaches transferring the images from a digital camera to a computer separate from the digital camera and the references Aihara/Moghadam/Seal does not teach this feature. The examiner respectfully disagrees as Aihara does teach transferring images from digital camera to a separate computer ( see at least col.9, lines 28-33, “....*A formatted HTML file is then generated using the captured images and the entered information. .... The HTML file may then be downloaded from the camera (e.g., via removable storage media, via universal serial bus, or some other means), for example, to a PC for storage in a database, or to a web server for display as a web page.*”, and col.13, lines 58-60, “ *For example, a wireless modem can be used.....*”). Note: The captured images from the digital camera are transferred to a separate PC.).

The applicant further argues that transferring images in a formatted HTML file format is not the same as transferring images. The examiner respectfully disagrees. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., images are not transferred in a formatted HTM file) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The applicant further argues with respect to claims 5, 8 and 11 that clearing of the images is done for a reason different than the one provided by the examiner while taking Official Notice. In response, the examiner would like to state that it is not necessary for the reference to actually suggest changes or modifications which

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applicant made. The PTO can satisfy the burden of obviousness under section 103 by showing some objective teaching in the prior art or knowledge generally available to one of an ordinary skill in the art. Kindly refer to the following court cases:

(a) *In re Scheckler*, 168 USPQ 716 (CCPA 1971): It is not necessary that a reference actually suggest changes or possible improvements which applicant made, (b) *In re Fine*, 5 USPQ2d 1596 (CA FC 1988): The PTO can satisfy the burden under section 103 to establish a prima facie case of obviousness "by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.", (c) *In re Bozek*, 163 USPQ 545 (CCPA 1969): "Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness 'from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.'", (d) *In re Gershon, Goldberg, and Neiditch*, 152 USPQ 602 (CCPA 1967): "Although references do not disclose or suggest the existence of applicants' problem or its cause, claims are rejected under 35 U.S.C. 103 since references suggest a solution to problem; it is sufficient that references suggest doing what applicants did, although they do not teach or suggest exactly why this should be done, other than to obtain the expected superior beneficial results.", (e) *In re Beattie*, 24 USPQ2d 1040 (CA FC 1992): "Board of Patent Appeals and Interferences correctly held that it would be obvious to one having ordinary skill in art to combine prior art references in order to arrive at claimed marking system for reading and playing music on keyboard or stringed instruments, despite absence of single express teaching of marking system which combines two musical theories of prior art references, since law of obviousness does not require that references be combined for reasons contemplated by inventor, but only looks to whether some motivation or suggestion to combine references is provided by prior art taken as whole.", and (f) *In re Dillon*, 16 USPQ2d 1897 (CA FC 1990): "Each situation must be considered on its own facts, but it is not necessary in order to establish a prima facie case of obviousness that both a structural similarity between a claimed and prior art compound (or a key component of a composition) be shown and that there be a suggestion in or expectation from the prior art that the claimed compound or composition will have the same or a similar utility as one newly discovered by applicant."

In view of the foregoing the rejection of amended claims 1, 4-8 and 10-11 is maintained. This is a Final rejection.

3. Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific

limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Claim Rejections - 35 USC § 103***

4 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4.1. Claims 1, 4, 6-7, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aihara in view of Moghadam and further in view of Seal.

Regarding claim 1, Aihara discloses a method of providing an inventory of digital images for a client(see at least abstract, and col.2, lines 59-67) comprising the steps of: acquiring digital images of items for the inventory using a digital camera (see at least col.6, lines 50-59, “ *Referring now to FIG. 1, a block diagram of a digital camera 110 is shown for use in accordance with the present invention. .... using a capture button or some other means, instructed camera 110 to capture an image of object 112, . . . . “); transferring the images to memory in a computer separate from the digital camera.( see at least col.9, lines 28-33, “*....A-formatted-HTML-file-is-then-generated-using-the**

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*captured images and the entered information. .... The HTML file may then be downloaded from the camera (e.g., via removable storage media, via universal serial bus, or some other means), for example, to a PC for storage in a database, or to a web server for display as a web page. " , and col.13, lines 58-60, " For example, a wireless modem can be used.....". Note: The captured images from the digital camera are transferred to a separate PC.).*

*formatting the images in the computer (see at least col.7, lines 11-21, " The present invention provides an inexpensive method and system for capturing images and generating a formatted electronic document which includes those images. The document is readily interchangeable among users using a variety of computer implemented methods, such as, for example, email, LAN/WAN, or the Internet. The present invention provides a process of creating the formatted document including the image which is intuitive and user friendly. The document can be created in any of a number of formats. Such formats include, for example, HTML format, Postscript format, Acrobat format, and the like. "); and*

*transferring the images to a storage medium for the client(see at least col.3, lines 36-41, "The HTML file can then be downloaded from the digital camera using, for example, a removable storage device (flash disk, PC Card, etc.). Alternatively, in another embodiment, the HTML file can be made directly available over the Internet through the use of a web server hosted by the digital camera itself. " ).*

Aihara does not disclose encrypting the formatted images in the computer. However, in the same field of endeavor, Moghadam discloses encrypting the images (see at least col.1, line 45-col.2, line 15, " .....In applications where photographic film images are taken for the record, e.g., crime scenes, documentation of an inventory, or insurance claims, the existence of a means of authenticating the contents of the image after it has been digitized by a scanner is extremely desirable. For example, a photographic system wherein any tampering with a digital image produced from a photographic original, either film or print, can be easily proven would be valuable to the

*photojournalist or criminal investigator. As another example, consider a photographer who shoots a roll of film and sends it to the photofinisher for development, digitization, and storage in a common database that is accessible to many users over ordinary dial-up telephone lines. It is often desirable to scramble (encrypt) the digital image in some form so that only the intended recipient(s) can decrypt it. Also, the photographer may wish to "sign" the digital image in a manner that allows her to prove authorship in support of a claim of copyright or to prove that a digital image has not been tampered with.....").* In view of Moghadam, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Aihara to incorporate the feature of encrypting the formatted images [please note Aihara already teaches formatting the images as analyzed above] because, as explicitly disclosed in Moghadam, to avoid tampering of the formatted digital images and that the intended recipients only should be able to decrypt the images.

Aihara in view of Moghadam does not further disclose applying a PIN to the encrypted images | the computer. Seal, in the same field of endeavor of personal identification, discloses applying PIN when accessing a network or user's own personal account number, etc. as a form of security to safeguard the access from unintended persons (see at least col.1, lines 22-34, "*... In today's world of electronic communication and commerce, the ability to identify a person, for the purposes of security in remote transactions is paramount. A common form of security is a simple password which, for example, is entered when a user wishes to access a computer network. Another form of security, which is widely used in bank automatic teller machines (ATMs), is a personal identification card, which holds on a magnetic strip encoded information such as the owner's personal details and account number, which is used in combination with a personal identification number (PIN) entered by the user when the transaction is initiated ..*"). In view of Seal, it would have been obvious to one of an ordinary skill in the art at the time

of the applicant's invention to have modified Aihara in view of Moghadam to incorporate the feature of applying PIN to the encrypted images [please note Aihara in view of Moghadam already teaches encrypting formatted images, as analyzed above] because, as explicitly disclosed in Seal, to provide a form of security to safeguard the access of the images to only intended recipients .

Regarding claims 4 and 6, Aihara in view of /Moghadam, further in view of Seal as applied to claim 1 above further discloses storing the digital images in a temporary memory in the camera (see at least 36-41, "*The HTML file can then be downloaded from the digital camera using, for example, a removable storage device (flash disk, PC Card, etc.). Alternatively, in another embodiment, the HTML file can be made directly available over the Internet through the use of a web server hosted by the digital camera itself.*" Note: the flash disk or the PC card corresponds to a temporary memory in the camera.) and transmitting the digital images from the temporary memory to the computer over a wireless link ( see at least col.9, lines 28-33, "...*A formatted HTML file is then generated using the captured images and the entered information. .... The HTML file may then be downloaded from the camera (e.g., via removable storage media, via universal serial bus, or some other means), for example, to a PC for storage in a database, or to a web server for display as a web page.*" , and col.13, lines 58-60, " *For example, a wireless modem can be used.....*". Note: the removable storage media in camera corresponds to the temporary memory as described above.).

Regarding claim 7, Aihara in view of /Moghadam, further in view of Seal as applied to claim 4 above discloses generating thumb print images corresponding to the

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inventory images (see at least col.4, lines 26-30. printing and displaying icons by the image capturing device, i.e. a digital camera corresponds to generating thumb print images of the inventory objects) ; storing the inventory images in a folder in a temporary memory in the camera; and storing the corresponding thumb print images in a folder within the inventory folder ( storing the images in a temporary memory in the camera is already covered in claim 4 above and regarding file/folder of the images see col.3, lines 1-40 which discloses generating a HTML file).

Regarding claim 10, Aihara in view of /Moghadam, further in view of Seal as applied to claim 1 above discloses a method for providing an inventory of encrypted digital images. Aihara further discloses that the storage medium is a CD-ROM or a secured server memory (see at least col.9, lines 28-33, “*....A formatted HTML file is then generated using the captured images and the entered information. .... The HTML file may then be downloaded from the camera (e.g., via removable storage media, via universal serial bus, or some other means), for example, to a PC for storage in a database, or to a web server for display as a web page.*” Note: the web server is the storage medium for the encrypted images. Since the images are encrypted it is expected that the web server is a secured server.).

4.2. Claims 5, 8 and 11 are rejected under 35 U.S.C. 103(a) as being obvious over Aihara in view of Moghadam , in view of Seal and further in view of Official Notice.

Regarding claim 5, Aihara in view of /Moghadam, further in view of Seal as applied to claim 4 above further discloses connecting the temporary memory to the

computer to transfer the digital images (see at least col.9, lines 28-33, “....A *formatted HTML file is then generated using the captured images and the entered information.* .... *The HTML file may then be downloaded from the camera (e.g., via removable storage media, via universal serial bus, or some other means), for example, to a PC for storage in a database, or to a web server for display as a web page.* “. Note: the removable storage media in camera corresponds to the temporary memory as described above.). Aihara in view of /Moghadam, further in view of Seal as applied to claim 4 does not disclose clearing the digital images from the temporary memory. However, the examiner takes an official notice of the concept and benefits of clearing the digital images from the temporary memory as of a removable storage media. It was notoriously well known at the time of the applicant’s invention to erase the images from the removable storage media after downloading them into a storage media of a PC, for example the film cartridge and then use them again as empty cartridge to expand the picture-taking capacity of the digital camera. In view of the official notice it would have been obvious to a person of an ordinary skill in the art at the time of the applicant’s invention to incorporate the concept and benefits of the official notice in clearing the digital images from the temporary memory because, as explained above, the temporary memory that is the removable storage media in the form of a film cartridge can be reused again after clearing the digital images.

Regarding claim 8, the limitations are closely parallel to the claim 5 and therefore it is analyzed and rejected on the basis of same rationale.

Regarding claim 11, Aihara in view of /Moghadam, further in view of Seal as applied to claim 1 above discloses a method for providing an inventory of encrypted digital images. .). Aihara in view of /Moghadam, further in view of Seal as applied to claim 4 does not disclose deleting the encrypted formatted images from the computer memory. However, the examiner takes an official notice of the concept and benefits of deleting the encrypted formatted images from the computer memory. It was notoriously well known at the time of the applicant's invention to erase the images from the computer memory if the images have been downloaded to a storage media like a CD-ROM for personal use and storage and they are not further needed in future to release the storage space for other use. In view of the official notice, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to incorporate the concept and benefits of the official notice in deleting the encrypted formatted images from the computer memory because, as explained above, it will make available the occupied storage space in the computer for other intended use if the intended use for the images stored in the computer memory is accomplished and fulfilled.

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

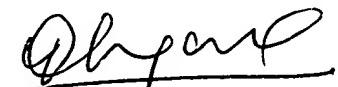
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Yogesh C Garg  
Primary Examiner  
Art Unit 3625

YG

November 29, 2004